

Submission of Certified Translation of Priority Application

Applicants submit herewith a verified translation of the German priority application DE 102 26 115.6, filed June 12, 2002.

Remarks

The Office Action dated November 10, 2009, has been received and carefully reviewed. The preceding amendments and the following remarks form a full and complete response thereto.

Claims 1, 7 and 8 have been amended. Support for the amendments can be found, for example, in the specification at ¶¶ 0056-00058, and in Figs. 6 and 7. No new matter has been added. Claims 3-6 and 9-37 have been cancelled without prejudice or disclaimer.

Claims 1, 2, 7 and 8 are pending in the present application and are submitted for consideration.

Drawings

An objection was made to the drawings because text in Figs. 3 and 8 was not in English. As noted above, Figs. 3 and 8 have been amended to replace the German text with English. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

Abstract and Specification

Objections were made to the Abstract and Specification for minor informalities. The informalities pointed out by the Examiner have been corrected. Accordingly, withdrawal of the objections to the abstract and specification is respectfully requested.

Claim Objections

Objections were made to the claims for minor informalities. The informalities pointed out by the Examiner have been corrected by the amendments to the claims set forth above. Accordingly, withdrawal of the claim objections is respectfully requested.

Rejection of Claims under 35 U.S.C. § 112

Claims 1, 2 and 6-8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 6 has been cancelled, and its subject matter has been incorporated into claim 1. Applicant respectfully traverses the rejections of claims 1, 2, 7 and 8 for the following reasons.

Independent Claim 1

The Examiner alleged that claim 1 was indefinite because “it is not clear how a line may be filled with a grating pattern.” Office Action at p. 6. Claim 1 has been amended to make clear that it is the “contour determined the contour line” and not the contour line itself that is filled with the grating pattern. Accordingly, the metes and bounds of claim 1 would be easily ascertained by the skilled person, and claim 1 is not indefinite. Withdrawal of the rejection is respectfully requested.

Dependent Claim 7

The Examiner alleged that claim 7 was indefinite because it was unclear to which of the previously recited “grating lines” the recited “a grating line” referred. Office Action at pp. 6-7. Claim 7 has been amended by replacing “a grating line” with “each of the grating lines.” Thus, it is clear that “each of the grating lines” refers each of the previously recited “grating lines.” Accordingly, amended claim 7 is not indefinite, and withdrawal of the rejection is respectfully requested.

Dependent Claim 8

The Examiner alleged that claim 8 was indefinite because the limitation “the starting points and end points of grating lines located side by side are connected” was “unclear and confusing.” Office Action at p. 7. In explaining the rejection, the Examiner began by asserting

that “[i]t is not clear whether the starting points and the end points refer back to the start and end points recited in Claim 7, or if they refer to separate and unique start and end points not previous recited.” *Id.* However, the basis for the rejection is unclear because the claim makes perfectly clear that that starting and end points referred to are those “of grating lines located side by side.” Claim 8.

The Examiner next asserts that “it is not clear how the connection between points is to be made.” But, a claim is not indefinite merely because it is broad. “If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate.” MPEP 2173.02 (citing *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993)). Here, a person of ordinary skill in the art would understand that infringement would be avoided by **not** connecting the starting and end points of grating lines located side by side to form a meandering processing path. Although the manners in which the starting and end points of grating lines located side by could be connected to form the meandering processing path described in the specification would be readily apparent to one of ordinary skill in the art, Applicant is not required to claim a specific manner in which “the starting and end points ... are connected to form a meandering processing path.” Thus, the rejection under 35 U.S.C. § 112, second paragraph, is inappropriate, and its withdrawal is respectfully requested.

Rejection of Claims under 35 U.S.C. §§ 102

Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,784,200 to Modegi (“Modegi”). Applicant respectfully traverses the rejections and submits that claims 1 and 2 are patentable for the following reasons.

Claim 1, upon which claims 2, 7 and 8 depend, is drawn to a method for producing a grating image of a security element. The grating image at least has one grating field separately perceptible with the naked eye. The method includes the steps of defining a contour line of the at least one grating field and filling a contour determined by the contour line with a grating pattern. The grating pattern within the contour line is described by **grating coordinates**. The method also has the steps of supplying the grating coordinates to a writing apparatus and producing the grating pattern in a substrate with the writing apparatus and with help of the grating coordinates. **The grating coordinates of grating lines are sequentially sorted according to their spatial disposition.**

Applicant respectfully submits that claim 1 is not anticipated by Modegi because Modegi does not disclose each and every feature of claim 1. For example, Modegi does not disclose that **“grating coordinates of grating lines are sequentially sorted according to their spatial disposition,”** as required by claim 1. (emphasis added). It was admitted in the Office Action that Modegi does not disclose that “the grating coordinates of the grating lines [are] sequentially sorted according to their spatial disposition.” Office Action at 9. Thus, the rejection of amended claim 1 as anticipated by Modegi is improper. Reconsideration and withdrawal of the rejection of claim 1 is respectfully requested.

Claim 2 depends on independent claim 1 and is patentable over Modegi for the same reasons discussed above with regard to claim 1 as well as for the additional limitation it recites.

Rejection of Claims under 35 U.S.C. § 103

Claim 6 was rejected under 35 U.S.C. § 103(a) as being obvious over Modegi in view of U.S. Patent Application Pub. No. 2003/0160192 to Inanami et al. ("Inanami"). Claim 6 has been cancelled, but its subject matter has been incorporated into claim 1. Applicant respectfully traverses the rejections and submits that claim 1 is patentable for the following reasons.

Applicant has submitted herewith a verified translation of foreign priority application DE 102 26 115.6 in accordance with 37 C.F.R. § 1.55. Accordingly, Applicant may rely on the June 12, 2002 filing date of the foreign priority application to overcome this rejection. Applicant's foreign priority date of June 12, 2002, is before Inanami's publication on July 13, 2006, and before Inanami's filing date of September 27, 2002. Thus, Inanami is not prior art under 35 U.S.C. § 102 and is unavailable as prior art under 35 U.S.C. § 103. Therefore, the rejection of claims over Modegi in view of Inami is improper, and its withdrawal is respectfully requested.

Conclusion


All of the stated grounds of rejection have been sufficiently addressed herein. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. Applicant submits that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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By



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